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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,687	12/19/2003	Jeffrey A. Hubbell	158264-0003	7788

32256 7590 03/07/2006

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EXAMINER

SZEKELY, PETER A

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,687

Applicant(s)

HUBBELL ET AL.

Examiner

Peter Szekely

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicants claim for priority going back to 1992 is denied. Applicants' claim 19 and new claim 37 encompass all ionically and covalently crosslinkable macromers and mixture of ionically and covalently crosslinkable macromers, that is the entire genera, while Exhibit 1 and Figures 1A to 1J show species of said genera. See Exhibit 1 and paragraphs 0039 and 0040 of US 2004/0138329 (applicants' published application). The underlying science does not extend the support from the species to the entire genus. In other words applicants' claims are broader than the support shown in the applications predating 8/1/1995. The effective filing date of the instant application remains August 1, 1995.

Double Patenting

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 19 and 37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 37-58 of U.S. Patent No. 5,334,640 (Reexamined). Although the conflicting claims are not identical, they are not patentably distinct from each other because the Reexamination Certificate discloses the species for applicants' genera. During reexamination claims 1-36 were cancelled and claims 37-58 were added. See Reexamination Certificate (4728th) of Desai et al. US 5,334,640. The priority date has no significance in the case of double patenting.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 19 is rejected under 35 U.S.C. 102(b or e) as being anticipated by Nisshinbo Industries, Inc. EP 0 555 980, Sumino et al. 4,791,061 or Kobayashi et al. 5,268,286.

6. Nisshinbo Industries discloses sodium alginate and sucrose in Example 1. Sumino et al. teach water soluble alginate in column 2, lines 25-29 and sodium, potassium and ammonium alginate in column 3, lines 11-14. Kobayashi et al. recite alginic acid derivatives in column 2, lines 33-38 and claim 1 and sodium alginate in claims 2-3. US 2004/0138329 states in paragraph 0102 that in the event that a substance such as alginate is used the resulting macromer will be both ionically crosslinkable and covalently crosslinkable. See also previous Office actions for explaining the rejections. Applicants' claims are not novel.

7. Claim 37 is rejected under 35 U.S.C. 102(b or e) as being anticipated by Nissibo Industries, Inc. EP 0 555 980, Sumino et al. 4,791,061, Feijen et al. 5,041,292 or Kobayashi et al. 5,268,286.

8. Feijen et al. display a proteinaceous component and a polysaccharide in claim 1. Protein is a covalently crosslinkable macromer and polysaccharides are ionically crosslinkable macromer. The other references have been discussed already previously. Applicants' claims are not novel.

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9. The examiner's rejection is based on the third party submission of the reexamination procedure of U.S. Patent 5,334,640 to Desai et al., which is of record.

10. Claims 19 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Desai et al. 5,550,78, Soon-Shiong et al. 5,705,270, Soon-Shiong et al. 5,705,848, Gunther et al. 5,736,595, Soon-Shiong et al. 5,837,747, Soon-Shiong et al. 5,846,530 or Mathiowitz et al. 5,985,354.

11. All references have been discussed in previous Office actions. Since the effective filing date of the instant application is 8/1/95, all the above references read on applicants' invention. Applicants' claims are not novel.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
3/2/06